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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,216	01/02/2004	Philip S. Siegel	067439.0157	1168
5073	7590	11/19/2008		
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER SHAAWAT, MUSSA A	
			ART UNIT 3627	PAPER NUMBER
			NOTIFICATION DATE 11/19/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/751,216

Applicant(s)

SIEGEL, PHILIP S.

Examiner

MUSSA A. SHAAWAT

Art Unit

3627

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 8 and 10-32 is/are pending in the application.
- 4a) Of the above claim(s) 17-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-8, 10-16 and 29-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Supplemental Action

1. This action is in response to communications filed on 07/25/2008. Claims 1, 5, 10, 29 and 31-32 have been amended. Claims 1-5, 7-8, 10-16 and 29-32 are pending examination.
2. **This action is supplemental to the previous final action. Please disregard the previous final action.**

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 7-8, 10-16 and 29-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 and 35-46 of copending Application No. 09/817,353 referred to hereinafter as '353. Although the conflicting claims are not identical, they are not patentably distinct from each other. '353 teaches all the limitations of claims 1-5, 7-8, 10-16 and 29-32 of the present application except for generating data for printing a return label for a particular merchandise. '353 teaches initiating a return process in response to receiving the electronic selection which may include generating data for printing a return label, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to omit generating data for printing a return label from '353.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 7-8, 13, 15 and 30-32 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Arganbright et al., US Patent No. (6,980,962) referred to hereinafter as Arganbright in view of Cybul et al., US Patent No. (6,246,997) referred to hereinafter as Cybul.

Claim 1: Arganbright discloses a method of using the Internet to provide return labels to customers for facilitating returns of merchandise, comprising the steps of: receiving, from a customer, an electronic request via a web access tool associated with the customer, the electronic request to initiate return processing of merchandise having been purchased by the customer in a prior purchase transaction, (see at least col.62. line 65-col.63 line 10); In response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, generating data for printing a return label for the particular item of merchandise selected by the customer, (see col. 63 lines 29-35); and in response to the electronic selection of the item, initiating a returns process for the particular item of the merchandise chosen by the consumer (see at least col.63 lines 8-11);

Arganbright does not expressly teach accessing a database to obtain transaction information associated with customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction; displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise having been

purchased by the customer in the prior purchase transaction; receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic transaction selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing;

However Cybul teaches accessing a computerized database to obtain the shopping or transaction history associated with the consumer (see at least Abstract, and col.4 lines 40-50); displaying the previous transaction or shopping history via a web browser interface where the previous shopping history is associated with the consumer (see at least col.3 line 65-col.4 lines 15); in response to displaying the transaction history associated with the consumer, receiving an electronic selection of a particular of at least an item by the consumer using the browser interface, the electronic selection comprising a click on the particular item of merchandise and identifying the particular item of merchandise (see at least col.4 lines 25-35, consumer selecting previous shopping history). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Cybul into the disclosure of Arganbright in order to provide the consumer with the option to return items via internet or online.

Claim 2: Arganbright teaches wherein the displaying step is performed by displaying a return information web page (see col.63 lines 5-10).

As per claim 5, the limitations of claim 5 are similar to the limitations of claim 1, therefore they are rejected based on the same rationale.

Claim 7/8: Arganbright teaches a method comprising the step of accessing a database to obtain merchant return rules, and displaying at least one of the merchant return rules, (see col.63 1-10).

Claim 13: Arganbright teaches the step of notifying a merchant of the return item, (see col. 63 lines 18-22).

Claim 15: Arganbright disclose downloading the data for printing a return label to the web access tool, (see col.63 lines 30-35).

Claim 30: Arganbright teaches updating a customer profile associated with customer (see col.65 lines 7-10).

Claim 31: Arganbright teaches a method of claim 1, further comprising sending a notification to a merchant associated with a particular item of merchandise of the

pending return, the notification identifying the customer and the particular item of merchandise (see col.63 lines 18-22).

Claim 32: the limitations of claim 32 are similar to the limitations of claims 1, 5, and 30-31, therefore claim 32 is rejected based on the same rationale.

6. Claims 3-4 and 10-12, 14, 16 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arganbright in view of Cybul et al., in further view of Roman et al., US PG Pub. No. (US 2002/0010634 a1) and official notice.

7.

Re claim 10: Arganbright nor Cybul do not expressly teach the step of determining whether the return is valid prior to the downloading step. However Roman teaches the step of determining whether the return is valid prior to the downloading step (see pp 0016 line 2 submitted return is analyzed for fraud against a database). It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Roman into the disclosure of Arganbright in order to prevent the invalid return of merchandise.

Re claim 11: Official notice is taken regarding the giving of notice that the request has been rejected and is made final. See e.g. US6192347 par. 517.

Claim 12: Arganbright nor Cybul do not expressly teach the step of performing the return is valid is performed by accessing one or more return rules associated with the merchant. However Roman teaches an e-tailer establishes parameter e.g. rules to

determining whether the return is valid, see pp 0016 Roman et al. It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Roman into the disclosure of Arganbright the motivation being the same as in claim 10.

Claims: 14/16: Arganbright nor Cybul do not expressly teach the step of notifying a merchant of information about the customer, and the step of delivering data about the return to a customer account record. However Roman et al discloses a merchant is notified of the return item (Roman et al. disclose information about the customer that he is returning the product undamaged, by the processing center pp0022 line 8).

Claims 3, and 4 official notice is taken regarding the old and notorious practice of generating a confirmation of a transaction on a separate page. See e.g., US6497408 par. 64. This official notice is hereby made final.

Claim 29: although Arganbright in view of Roman in further view of Cybul teach a customer returning/exchanging a product and accessing a database to obtain customer information such as name, receipt number, phone number and product description (see Roman et al). Neither Arganbright/Roman expressly teach customer information comprising customer-specific credit information or customer-specific shipping information.

Examiner takes Official Notice that accessing a database to obtain customer information comprising credit card information or shipping information of a customer is

well know and old in the art. It would have been obvious to modify the disclosure of Arganbright and Roman et al, to include accessing a database to obtain customer information comprising credit card information or shipping information of a customer, in order to credit the appropriate amount to the customer account or to ship back a defective product for example.

Response to Arguments

8. Applicant's arguments have been considered but are not persuasive. In particular applicant argues that A) Arganbright in view of Cybul does not teach, disclose, teach, or suggest "in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by a customer in a prior purchase transaction"; B) Arganbright in view of Cybul do not teach, disclose or suggest "in response to receiving the electronic selection comprising the click on the particular item of merchandise in the list of merchandise, initiating a returns process for the particular item, the returns process initiated by a returns server"

In response to A) the examiner respectfully disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. Arganbright teaches receiving from the consumer an electronic request to initiate return processing (see at least col. 63 lines 1-35). In addition Cybul teaches accessing a computerized database to obtain the shopping or transaction history associated with the consumer (see at least Abstract, and col.4 lines 40-50) and receiving an electronic selection of a particular of at

least an item by the consumer using the browser interface, the electronic selection comprising a click on the particular item of merchandise and identifying the particular item of merchandise (see at least col.4 lines 25-35, consumer selecting previous shopping history). Therefore, Arganbright in view of Cybul still meet the scope of the limitation as currently claimed.

In response to B) the examiner respectfully disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. Arganbright teaches receiving from the consumer an electronic request to initiate return processing (see at least col. 63 lines 1-35). In addition Cybul teaches receiving an electronic selection of a particular of at least an item by the consumer using the browser interface, the electronic selection comprising a click on the particular item of merchandise and identifying the particular item of merchandise (see at least col.4 lines 25-35, consumer selecting previous shopping history). Therefore, Arganbright in view of Cybul still meet the scope of the limitation as currently claimed.

Examine note: The official notice statement recited in the previous office action dated 11/29/2007, ***is taken to be admitted prior art because applicant failed to traverse the examiner's assertion of official notice. See, MPEP 2144.02.*** Furthermore the Official Notice Traversal is no longer seasonable, therefore the Official Notice is considered to be admitted prior art.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form 892 for cited references.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MUSSA A. SHAAWAT whose telephone number is (571)272-2945. The examiner can normally be reached on Mon-Fri (8am-5:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mussa A Shaawat/
Examiner, Art Unit 3627
November 15, 2008

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627